

REMARKS

In the Office Action mailed February 27, 2004, the disclosure was objected to for omitting reference number 46 from the drawings. An amended Figure 3 is submitted with this response adding the reference number 46. The disclosure was also objected to for reference number 48 failing to denote a hole in Figure 6. An amended Figure 6 is submitted herewith that shows the sleeve hole 48.

The drawing figures were also objected to for failing to show the fiber optic bore 46. Submitted herewith is an amended Figure 3 that adds the fiber optic bore 46 to the drawing figure.

In view of the above, it is respectfully submitted that the objections to the disclosure and drawings have been overcome.

Claims 2 and 4 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Specifically, it was contended that the claims recite subject matter that was not described sufficiently in the specification to enable one skilled in the art to make and/or use the subject matter of claims 2 and 4. It is also contended that lines 22-24 of page 8 of the specification failed to provide sufficient information to the ordinary skilled artisan to make and/or use the subject matter of claims 2 and 4.

It is respectfully submitted that the specification and claims provide sufficient information to the ordinary skilled artisan to make and/or use the subject matter of claims 2 and 4. Considering that the ordinary skilled artisan is familiar with the construction and use of microsurgical instruments employed in ophthalmic surgery, the application provides sufficient information to make and/or use the subject matter of

claims 2 and 4. Page 4, lines 27-29 of the specification specifically sets forth that retraction of the fiber tip into the sleeve is performed by first pushing the finger pad forward, causing the sleeve to move toward its pushed forward position and causing straightening of the bent portion of the optic fiber projecting from the sleeve. In addition to this explanation, page 8, lines 17-20 also sets forth that retraction of the tip is performed by first pushing the finger pad 26 forward causing the sleeve 20 to move toward its pushed forward position and causing straightening of the bent distal end portion 38 of the optic fiber projecting from the sleeve. These two portions of the specification make clear to the ordinary skilled artisan how the distal end portion of the optic fiber is retractable into the sleeve, as required by claim 2. Furthermore, these two portions of the specification make clear to the ordinary skilled artisan how the optic fiber distal end portion is retracted into the tube of the sleeve as required by claim 4.

In view of the portions of the specification identified above, and considering the level of skill possessed by the ordinary skilled artisan in the field of the design of microsurgical ophthalmic instruments, it is respectfully submitted that the subject matter of claims 2 and 4 is fully enabled by the specification, and the rejections of claims 2 and 4 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, it was contended that there was no antecedent basis for "the plastic" recited in claim 11.

However, claim 11 depends directly from claim 1. Claim 1 clearly sets forth a plastic optic fiber. It is therefore respectfully submitted that the recitation of "a plastic" in

Claim 1 provides antecedent basis for “the plastic” recited in claim 11, which depends directly from claim 1. In view of this, it is requested that the rejection of claim 11 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 1-4 and 7-14 were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable in view of the patent publication of Loeb No. 2002/0193781. Claims 5, 6, 17 and 19-21 are also rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable in view of the Loeb reference and further in view of the U.S. Patent of Esch, et al. No. 5,469,524.

The rejection of claims 17 and 19-21 made in the Office Action is unclear. As stated in the Office Action, the rejection of these claims is based on the disclosure of the Loeb reference as the primary reference, and the Esch reference as the secondary reference. However, claim 17 depends from claim 16, which depends from claim 15. Claims 19-21 all depend from claim 15. Claim 15 has not been rejected in the Office Action in view of the Loeb reference as the primary reference.

In view of the above, the basis for the rejection of claims 17 and 19-21 is unclear and unexplained in the Office Action.

Of the rejected claims 1-4 and 7-14, claim 1 is the only independent claim.

In the rejection of claims 1-4 and 7-14, it is contended that the Loeb reference discloses a “tubular sleeve 2 and optical fiber 6 having an adjustable bend therein (since it is fixed within cannula 4 which has a preformed bend)”. However, this is not the subject matter of the invention recited in claim 1. Claim 1 requires “a plastic optic fiber..., the distal end portion of the optic fiber having an adjustable bend therein”.

Thus, the claim recites an optic fiber with a bend, not a cannula with a bend. Thus, as

admitted in the Office Action, the Loeb reference fails to disclose or suggest the subject matter of the invention recited in claim 1. In view of this first shortcoming of the Loeb reference, it is submitted that the reference fails to provide sufficient information to the ordinary skilled artisan to make obvious the subject matter of claim 1, and the claim is allowable over the prior art.

Claims 2-4 and 7-14 all depend from claim 1 and therefore are allowable over the prior art for the reasons set forth above.

Furthermore, the rejection of claim 1 acknowledges that the Loeb reference fails to disclose the optic fiber being plastic, an important feature of the claimed invention. The rejection continues by contending that it is old and well known in the art to use plastic as the material for optical fibers. However, the rejection provides no documentary evidence of this. In view of this, it is submitted that the rejection of claim 1, by omitting any prior art to support the basis for the rejection, fails to establish a prima facie case of obviousness.

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based". Zurko, 258 F3d at 1385, 59 USPQ 2d at 1697 (MPEP §2144.03.

Based on the case law and the requirements of the MPEP set forth above because there is no evidentiary support for the rejection, the rejection of claims 1-4 and 7-14 has failed to establish a prima facie case of obviousness, and the claims are allowable over the prior art.

Claims 5, 6, 17 and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the Loeb reference and the Esch reference. Of the rejected

claims, claims 5, 6, and 17 all depend from claim 1. For the reasons set forth above, i.e. the failure to establish a prima facie case of obviousness regarding the subject matter of claim 1, claims 5, 6, and 17 are allowable over the prior art.

Claims 19-21 all depend from independent claim 15, which is not rejected in view of the Loeb reference in the Office Action. It therefore appears that this rejection of claims 19-21 is made in error, and the claims are allowable over the prior art.

Claims 15, 16, 18, and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the U.S. patent of Esch, et al. No. 5,469,524. Of these rejected claims, claim 15 is the only independent claim.

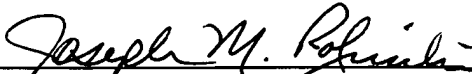
Like claim 1, claim 15 requires "a plastic optic fiber". The rejection of claim 15 admits that Esch reference fails to disclose an optic fiber that is plastic. Therefore, for the same reasons discussed above with regard to claim 1, it is submitted that the rejection of claim 15 fails to establish a prima facie case of obviousness. For the same reasons discussed above with regard to claim 1, claim 15 is not made obvious in view of the prior art, and is allowable over the prior art.

Claims 16-26 all depend from claim 15 and therefore are allowable over the prior art of record.

It is respectfully submitted that in view of the amendments and remarks presented herein, the application is in condition for allowance and favorable action is requested.

Respectfully submitted,

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